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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,943	02/22/2002	Dean Sadat-Aalace	00537-191002	3207
37903	7590	07/28/2004	EXAMINER	
DAWN JANELLE AT BIOMEASURE INC. 27 MAPLE STREET MILFORD, MA 01757			RUSSEL, JEFFREY E	
			ART UNIT	PAPER NUMBER
			1654	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/980,943

Applicant(s)

SADAT-AALAE ET AL.

Examiner

Jeffrey E. Russel

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 08 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See attachment.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 6 and 9.Claim(s) objected to: None.Claim(s) rejected: 1-5, 7, 8, 10 and 11.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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1. The proposed amendment after final rejection filed July 8, 2004 overcomes the objection set forth in section 1 of the final Office action.

2. The obviousness rejection set forth in section 3 of the final Office action is maintained. Applicants have not demonstrated that the subgenus of compounds possess an agonist activity not possessed by the genus disclosed by the WO Patent Application 98/24807. It should be noted that only rejected claim 5 mentions eliciting a somatostatin agonist response. The other rejected claims do not mention somatostatin agonist activity, and hence this is not a claim limitation which must be taught or suggested by the prior art. In any event, the prior art need not teach or suggest the intended uses or particular properties recited in Applicants' claims or disclosed in Applicants' specification. Patentability can not be based merely upon the employment of descriptive language not chosen by the prior art. In re Skoner, 186 USPQ 80, 82 (CCPA 1975). Accordingly, it is not determinative that the WO Patent Application '807 discloses its compounds to be antagonists rather than agonists. Further, the reason or motivation to modify a reference under 35 U.S.C. 103 need not be the same as Applicants' reasons or motivation. See MPEP 2144. Accordingly, motivation to modify the WO Patent Application '807 in order to arrive at further effective somatostatin antagonists can be sufficient motivation under 35 U.S.C. 103. Neither the examiner nor the rejection presumes a motivation to select agonist compounds. Finally, once a prima facie case of obviousness of a composition has been established, the burden is on Applicant to show that the claimed composition possesses a property not possessed by the prior art compositions or that they possess them to an unexpectedly greater degree. The discovery that a claimed composition possesses a property not disclosed for the prior art subject matter does not by itself defeat a prima facie of obviousness.

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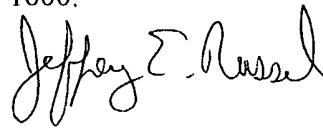
In re Dillon, 16 USPQ2d 1897 (CAFC 1990). As noted in the final Office action, Applicants have not demonstrated that the claimed peptides possess a somatostatin agonist activity not possessed by the peptides of the WO Patent Application '807. Applicants seem to be assuming that somatostatin agonist and antagonist activity is an either/or proposition, i.e. either a particular compound is a somatostatin agonist or it is a somatostatin antagonist. This assumption does not reflect the well-known phenomenon of receptor partial agonists, in which a compound binds to a receptor and causes activation of the receptor to a small degree, but by binding to the receptor prevents activation of the receptor to a larger degree by a full agonist. See also the final Office action, page 5, lines 2-10. An allegation or a non-comparative showing that certain peptides possess somatostatin agonist activity does not support a conclusion that they possess an activity not possessed by the peptides of the WO Patent Application '807.

In re Jones, 21 USPQ2d 1941 (CAFC 1992) is distinguished from the instant fact situation because in Jones, the genus of substituted ammonium salts was too broad to suggest the specific salt claimed by the Applicant. In contrast, the genus of the WO Patent Application '807 for the substituent A⁶ is thirteen members, of which four satisfy Applicants' claim requirements. Also, in Jones, it was multiple references which could not be combined because of their non-analogous uses (as herbicides, shampoos, and morpholine production). In the instant application, only a single reference is involved, and the uses of the peptides described in the WO Patent Application '807 (e.g., as imaging agents for cells possessing somatostatin receptors and in treating diseases or disorders associated with the need to promote the release of growth hormone) can be the same as or are consistent with those claimed by Applicants.

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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Bruce Campell can be reached at (571) 272-0974. The fax number for formal communications to be entered into the record is (703) 872-9306; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.

A handwritten signature in black ink, reading "Jeffrey E. Russel". The signature is written in a cursive style with a large, stylized "J" and "R".

Jeffrey E. Russel

Primary Patent Examiner

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JRussel

July 19, 2004